

--93. A method for protecting a dwelling against damage caused by termites, said method comprising fixing a composite material as claimed in Claim 83 to at least 50% of the total surface area of the interior wall of partitions and walls.

--94. A method according to Claim 93, wherein the composite material is fixed to at least 95% of the total surface area of the interior wall of partitions and walls.

--95. A dwelling having improved protection against damage caused by termites, wherein at least 50% of the total surface area of the interior wall of its partitions and walls is covered with a composite material as claimed in Claim 83.

--96. A dwelling according to Claim 95, wherein the composite material covers at least 95% of the total surface area of the interior wall of partitions and walls.

REMARKS

Entry of the foregoing amendment prior to examination on the merits is respectfully requested.

An abstract on a separate sheet has been added in accord with the Examiner's request in the April 14, 2000 Official Action.

New Claims 83-96, directed to particularly preferred embodiments of the invention, have been added by the foregoing amendment. Claims 12-96 are now in this application.

New Claims 83-85 parallel Claims 12-14, but require a termiticidally effective amount of the preferred active compound, i.e. 5-amino-3-cyano-1-(2,6-dichloro-4-trifluoromethylphenyl)-4-trifluoromethylsulfinylpyrazole (also known as fipronil), and further specify that the gypsum board has a thickness of between 0.5 and 5 cm, and that the cardboard or paper has a relative density of between 50 and 500 g/m². Claim 86 specifies a narrower range of gypsum board thickness and cardboard or paper density. Claims 87 and 88 specify particular thicknesses of the cardboard or paper sheet or sheets. Claims 89 and 90 specify particular amounts of the active compound. Claims 91 and 92 contain all of the specific features of the new Claims 83-90. Claims 93 and 94 parallel Claims 71 and 73, but are dependent from Claim 83, and thus contain the specific features thereof. Similarly, Claims 95 and 96 parallel Claims 79 and 81, but depend from Claim 83 and thus contain its specific features. All of the features set forth in the new claims are fully supported by the specification and claims as originally filed and indeed are found specifically in various of the claims which depend, directly or indirectly, from Claim 12. Thus, it is apparent that no new matter has been introduced. It is also apparent that the new claims are fully in keeping with the requirements of 35 U.S.C. §112. Further, these claims are believed to be unsuggested by the art of record. In particular, it is pointed out that Kodama et al do not suggest that a composite material having the characteristics as claimed herein could be successfully used to control termites with fipronil; Kodama et al do not teach how to treat building materials or particle board to termite-proof them, which is not surprising given the fact that the patent is primarily directed to soil treatment. Furthermore, the patent requires that fipronil be combined with a pyrethroid insecticide to effectively control termites; it is

the combination, not fipronil alone, which would be applied to particle board or building materials as taught by Kodama et al. Moreover, Kodama et al do not remotely suggest treating, not particle board, but paper or cardboard adhered to gypsum, with fipronil, either alone or combined with a pyrethroid. The gypsum-type materials identified by Kodama et al are carriers for their soil treatment and, again, even if these materials are used to make gypsum board, it is not the gypsum herein which comprises the fipronil but rather the paper/cardboard covering. JP 8-108403 requires not simply an insecticide but an antimicrobial insecticide and does not remotely suggest using a 1-phenylpyrazole insecticide, much less the specific compound of the new claims. There is no teaching in JP 8-108403 which would lead one of ordinary skill in the art to substitute fipronil therein, or to modify the structure therein (which requires a decorative surface veneer on the outside of the board on top of the antimicrobial insecticide). There would be no reasonable expectation of success which would lead one of ordinary skill to make such modifications. In DE 2438365, the insecticide is included in the gypsum itself, not in paper or cardboard adhered thereto; moreover, there is no suggestion that a 1-arylpyrazole, specifically fipronil, would be successful in the German document's board, much less in the composite material claimed herein. JP 94-0142138 relates to an insect repellant material, not an insecticide, and places the repellant in a synthetic resin on the surface of the basic material. It does not suggest that such a material could successfully be used to deliver an insecticide, much less a 1-phenylpyrazole insecticide, much less fipronil, and that the synthetic resin which is an essential part of reference's invention should be eliminated. JP 04265345 discloses ant-preventive construction materials in which the ant preventative is mixed into

several layers of the materials; there is no suggestion of using a termiticide, much less a 1-phenylpyrazole, much less fipronil; or of placing it only in paper/cardboard adhered to gypsum board. Finally, JP 90-0180462 relates only to the use of antifungal agents; it does not remotely suggest that an insecticide, much less a 1-phenylpyrazole, much less fipronil, could be incorporated in its material and provide successful control of termites. Indeed, it is apparent that not only new Claims 83-96 but all of applicants' claims are free of the art of record.

It is also apparent here that the cited references, separately or in combination, simply fail to teach or suggest the invention claimed herein. And, indeed, there is no basis for combining the cited references, for there is not even an allusion in any one of them for such combination. United Merchants, etc. v. Ladd, 139 U.S.P.Q. 199. Furthermore, where references are combined, it should be considered whether those references suggest doing what applicant did. In re Gruskin, 110 U.S.P.Q. 288. The references relied upon here in no way meet that burden. Indeed, the references are silent as to a possible combination and, as was succinctly stated in In re Burt & Walter, 148 U.S.P.Q. 548, "Silence in a reference is hardly a proper substitute for an adequate disclosure of facts upon which a conclusion of obviousness may justifiably follow." Also in point as regards the references separately or in combination is In re Wesslau, 147 U.S.P.Q. 391, in which the Court stated:

It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such a reference fairly suggests to one of ordinary skill in the art.

When fairly viewed, there is no question but that the cited references simply fail to teach or suggest applicant's invention and that all of the claims now in the application stand free of the 35 U.S.C. §103 rejection made in the April 14, 2000 Official Action.

An early, favorable Action on the merits is believed to be in order and is earnestly solicited.

Respectfully submitted,

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Date: January 23, 2001